



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,943	07/03/2003	Kerry McLellan	12620-7	5423
1059 7590 08/18/2008 BERESKIN AND PARR 40 KING STREET WEST BOX 401 TORONTO, ON M5H 3Y2 CANADA				
EXAMINER				
HAIDER, FAWAAD				
ART UNIT		PAPER NUMBER		
3627				
MAIL DATE		DELIVERY MODE		
08/18/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/611,943

**Applicant(s)**

MCLELLAN ET AL.

**Examiner**

FAWAAD HAIDER

**Art Unit**

3627

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-5 and 7-12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 3-5, and 7-12 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1, 3-5, and 7-12 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). The process steps in claims 1, 3-5, and 7-12 are not tied to another statutory class nor do they execute a transformation. Thus, they are non-statutory.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-5, and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huxter (2002/0103724), in view of Kuebert et al (2002/0165729).

Re Claim 1: Huxter discloses attempting a delivery at a primary location (see 109 in Figure 8, [0211]); if the delivery to the primary location fails, communicating a notification to the recipient of an upcoming delivery to a preferred redirection location (see 340 IN Figure 10A, [0017, 0189, 0203]).

However, Huxter fails to disclose selecting the preferred redirection location prior to the delivery, wherein the alternative redirection location is different from the primary location and the preferred redirection location, and receiving a response to the notification from the recipient after a failed delivery, wherein the response to the notification is adapted to change the preferred redirection location to an alternative redirection location, and delivering the parcel to the alternative redirection location. Kuebert discloses selecting the preferred redirection location prior to the delivery and also discloses alternate delivery locations, therefore more than one (see [0028, 0047]). Kuebert also discloses receiving a response to the notification from the recipient after a failed delivery, wherein the response to the notification is adapted to change the preferred redirection location to an alternative redirection location, and delivering the parcel to the alternative redirection location (see Abstract, [0017, 0029, 0041, 0048]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Huxter's invention with Kuebert's use of selecting an alternate location prior to delivery, and multiple delivery locations in order that "the recipient, sender, or mailer may flexibly change the delivery point of the item (see Kuebert Abstract)."

Re Claim 3: Huxter discloses wherein the notification step comprises an email to the recipient (see 1207 in Figure 4 and [0123]).

Re Claim 4: Huxter discloses wherein the notification step comprises a SMS message to the recipient (see 1206 in Figure 4 and [0123]).

Re Claim 5: Huxter discloses comprising batching manual records of deliveries (see [0182]).

Re Claim 7: Huxter discloses wherein prior to step (a), the method further comprises registering with a delivery service (see Figure 8).

Re Claim 8: Huxter discloses wherein the registration step comprises providing the preferred redirection location to the delivery service (see Figure 8).

Re Claim 9: Huxter discloses wherein the registration step comprises providing the primary location to the delivery service (see Figure 8).

Re Claim 10: Huxter discloses wherein the registration step comprises generating an identifier unique to the recipient (see 101-106 in Figure 8).

Re Claim 11: Huxter discloses wherein the registration step comprises generating an identifier unique to the transaction (see 211 in Figure 9).

Re Claim 12: Huxter discloses wherein the primary location is a residential address of the recipient (see [0018]) and Figure 39).

### ***Response to Arguments***

4. Applicant's arguments filed 5/15/2008 have been fully considered but are moot in view of the new grounds of rejection.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fawaad Haider whose telephone number is 571-272-7178. The examiner can normally be reached on Monday-Friday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 3627

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627

/Fawaad Haider/

Examiner

Art Unit 3627

FIH